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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/677,422	10/02/2003	Daniela T. Bratescu	15071US02	8452

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EXAMINER

STITZEL, DAVID PAUL

ART UNIT PAPER NUMBER

1616

DATE MAILED: 11/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/677,422		BRATESCU ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	David P. Stitzel, Esq.		1616	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 August 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3, 7, 8, 10-13 and 23-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-3, 7, 8, 10-13 and 23-32 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## OFFICIAL ACTION

### *Acknowledgment of Receipt*

The new Examiner of record acknowledges Receipt of the Applicants' Election of: *didecyl dimethyl ammonium chloride* as the patentably distinct species of *antimicrobial compound*; *C<sub>8</sub> alkyl sulfate* as the patentably distinct species of *anionic surfactant*; *C<sub>8</sub> amine oxide* as the patentably distinct species of *bridging surfactant*; and *betaine C<sub>8</sub> alkyl trimethyl ammonium chloride* as the patentably distinct species of *cationic surfactant*; which was filed on August 15, 2006, in response to the Official Action dated July 27, 2006.

However, every instance in which a betaine compound is mentioned within the instant specification is with respect to bridging surfactants and not cationic surfactants as set forth in the aforementioned Election. See e.g., paragraphs [0042], [0066], [0096], [0112], [0166], [0170], [0179], [0180], [0181], [0257], [0259], [0261] and [0264] of U.S. Pre-Grant Patent Application 2004/0071653, which is the published version of the instant application). As a result, the aforementioned Election is not fully responsive to the aforementioned Official Action. See 37 C.F.R. § 1.111.

### *Election & Telephone Interview Summary*

Pursuant to a telephone interview held with the attorneys of record, namely Mr. Troy A. Groetken, Esq., and Mr. James H. Williams, Esq., on Friday, October 13, 2006, at approximately 10:30 AM EST, an election was made to prosecute ~~betaine~~ *C<sub>8</sub> alkyl trimethyl ammonium chloride* as the patentably distinct species of *cationic surfactant*.

### *Status of Claims*

Claims 4-6, 9 and 14-22 were canceled, and claims 23-32 were added, by a preliminary amendment filed on October 2, 2003. As a result, claims 1-3, 7, 8, 10-13 and 23-32 are currently pending.

***Restriction Requirement***

Upon further consideration by the new Examiner of record, Restriction to one of the following inventions is also required under 35 U.S.C. § 121:

- I. Claims 1-3, 8, 10-13, 23, 24 and 26-32 are drawn to an antimicrobial surfactant blend composition comprising: an antimicrobial compound; an anionic surfactant; a bridging surfactant; and an optional cationic surfactant, as classified in class 514, subclass 642.
- II. Claim 7 is drawn to a method of controlling the growth of microorganisms comprising contacting a surface with an antimicrobial surfactant blend composition comprising: an antimicrobial compound; an anionic surfactant; a bridging surfactant; and an optional cationic surfactant, as classified in class 424, subclass 70.24.
- III. Claim 25 is drawn to a method for preparing an antimicrobial surfactant blend composition comprising combining an antimicrobial compound, an anionic surfactant, a bridging surfactant, and an optional cationic surfactant, as classified in class 424, subclass 70.28.

Inventions I and II are related as a product and a method of using said product, respectively. The inventions can be shown to be distinct if either or both of the following can be shown that: (1) the method of using the product as claimed can be practiced with another materially different product; or (2) the product as claimed can be used by another method that is materially different from the instantly claimed method of using said product. See MPEP § 806.05(h). In the instant case, an antimicrobial surfactant blend composition as claimed in Invention I can be used by another method that is materially different from the method claimed in Invention II. For example, as opposed to a method of using said antimicrobial surfactant blend composition for controlling the growth of microorganisms on

a surface as claimed in Invention II, the composition claimed in Invention I may alternatively be used for removing oligomer deposits from polyester fibers and polyester processing equipment.

Inventions I and III are related as a product and a method of making said product. The inventions can be shown to be distinct if either or both of the following can be shown that: (1) the method of making the product as claimed can be used to make a materially different product; or (2) the product as claimed can be made by another method that is materially different from the instantly claimed method of making said product. See MPEP § 806.05(f). In the instant case, a an antimicrobial surfactant blend composition as claimed in Invention I can be made by another method that is materially different from the method claimed in Invention III. For example, as opposed to making an antimicrobial surfactant blend composition as claimed in Invention III, the antimicrobial surfactant blend composition claimed in Invention I, may alternatively be made by purchasing an antimicrobial surfactant premix comprising: an antimicrobial compound; an anionic surfactant; and a bridging surfactant, and then combining, immediately prior to use, an optional cationic surfactant.

Inventions II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects. See MPEP §§ 802.01 and 806.06. In the instant case, the method claimed in Invention II has a function and effect of controlling the growth of microorganisms on a surface comprising applying an antimicrobial surfactant blend composition to said surface, whereas the method claimed in Invention III has a function and effect of making an antimicrobial surfactant blend composition. As a result, the method claimed in Invention II has a materially different function and effect from the method claimed in Invention III, and are therefore unrelated.

Because these inventions are independent and distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, the prior art search required for each

respective invention would be divergent, thereby causing an undue search burden. As a result, restriction for examination purposes as indicated is proper. Applicants are therefore required under 35 U.S.C. § 121 to elect a single invention for prosecution on the merits.

### ***Election of Species Requirement***

In furtherance of the aforementioned Election of August 15, 2006, a *C<sub>8</sub> alkyl sulfate* is not a patentably distinct species of *anionic surfactant*, but rather a subgenus thereof, since there are numerous structural isomers of a *C<sub>8</sub> alkyl sulfate*. Even though this requirement is traversed, Applicants are required under 35 U.S.C. § 121 to elect, for search purposes only, a *single disclosed patentably distinct species of a C<sub>8</sub> alkyl sulfate* (i.e., *n-octyl sulfate*, a.k.a., *Polystep B-29*; See e.g., paragraph [0142] of U.S. Pre-Grant Patent Application 2004/0071653, which is the published version of the instant application). for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held allowable.

In addition, a *C<sub>8</sub> amine oxide* is not a patentably distinct species of *bridging surfactant*, but rather a subgenus thereof, since there are numerous structural isomers of a *C<sub>8</sub> amine oxide*. Even though this requirement is traversed, Applicants are required under 35 U.S.C. § 121 to elect, for search purposes only, a *single disclosed patentably distinct species of a C<sub>8</sub> amine oxide* (i.e., *N,N-dimethyl-n-octylamine oxide*, a.k.a., *Ammonyx C8*; See e.g., paragraph [0169] of U.S. Pre-Grant Patent Application 2004/0071653, which is the published version of the instant application) for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held allowable.

Furthermore, a *C<sub>8</sub> alkyl trimethyl ammonium chloride* is not a patentably distinct species of *cationic surfactant*, but rather a subgenus thereof, since there are numerous structural isomers of a *C<sub>8</sub> alkyl trimethyl ammonium chloride*. Even though this requirement is traversed, Applicants are required under 35 U.S.C. § 121 to elect, for search purposes only, a *single disclosed patentably distinct*

*species of a C8 alkyl trimethyl ammonium chloride* (i.e., *N,N,N-trimethyl-n-hexadecylammonium chloride*, a.k.a., *Cetac-30*; See e.g., paragraph [0132] of U.S. Pre-Grant Patent Application 2004/0071653, which is the published version of the instant application) for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held allowable.

In addition to including a listing of all claims, as well as any claims subsequently added thereto, which are readable upon the elected species, Applicants should also include a chemical structure or a molecular formula of the elected compound, if a chemical structure or a molecular formula of said compound is not already contained within the instant specification. If Applicants are unable to provide the chemical structure or the molecular formula of said compound, the trade name of, or the CAS (Chemical Abstract Service) number assigned to, said compound will suffice.

Since the aforementioned Election appears to be *bona fide*, Applicant is given ONE (1) MONTH or THIRTY (30) DAYS from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 C.F.R. § 1.136(a).

#### ***Contact Information***

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to David P. Stitzel, M.S., Esq., whose telephone number is 571-272-8508. The Examiner can normally be reached on Monday-Friday, from 7:30AM-6:00PM.

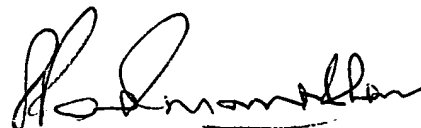
If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Johann Richter, Ph.D., Esq., can be reached at 571-272-0646. The central fax number for the USPTO is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published patent applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished patent applications is only available through Private PAIR. For more information about the PAIR system, please see <http://pair-direct.uspto.gov>. Should you have questions about acquiring access to the Private PAIR system, please contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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